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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/957,451	09/21/2001	Marc O. Schurr	06530.0276-00000	2507

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP  
901 NEW YORK AVENUE, NW  
WASHINGTON, DC 20001-4413

EXAMINER
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EREZO, DARWIN P

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/957,451

Applicant(s)

SCHURR ET AL.

Examiner

Darwin P. Erez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-7, 120, 121, 124, 126, 127, 129-135, 137, 138, 140, 142-157 and 164-171 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/21/06</u> . | 6) <input type="checkbox"/> Other: _____  |

Continuation of Disposition of Claims: Claims pending in the application are 1,2,4-7,120,121,124,126,127,129-135,137,138,140,142-157 and 164-171.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 4-7, 120, 121, 124, 126, 127, 129, 131-135, 137, 138, 140, 142, 144-152; 154-157 and 164-171 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,676,676 to Porter.

As to claims 1, 2, 4- 7 and 164, Porter teaches a clip having a first arm and a second arm **12** disposed substantially opposite from each other; wherein the first and second arms define an opening capable of receiving a fold of tissue; wherein both the second and first arm includes integral anchoring portions **38** configured to maintaining a non-contacting relationship with each other of the first and second arms during a deployed state (see Figs. 6 and 7); wherein the first and second arms are configured to frictionally engage the outer surface of the tissue (once in the deployed and locked state); wherein the bottom arm shown in Fig. 1 includes a fixation hole **28** configured to receive an anchoring member **26** from the opposite arm; wherein the device further includes a gripping tab **36**; wherein the device is bioabsorbable (col. 3, line 46); wherein the arms form a substantially U-shaped configuration (Fig. 6); and wherein the device is permanently implantable. It is noted that the device clip of Porter is fully capable of securing a flat piece of tissue such that the lock tab penetrates said tissue (not shown).

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In this configuration, the tissue would be extending beyond a second end of the first and second arms.

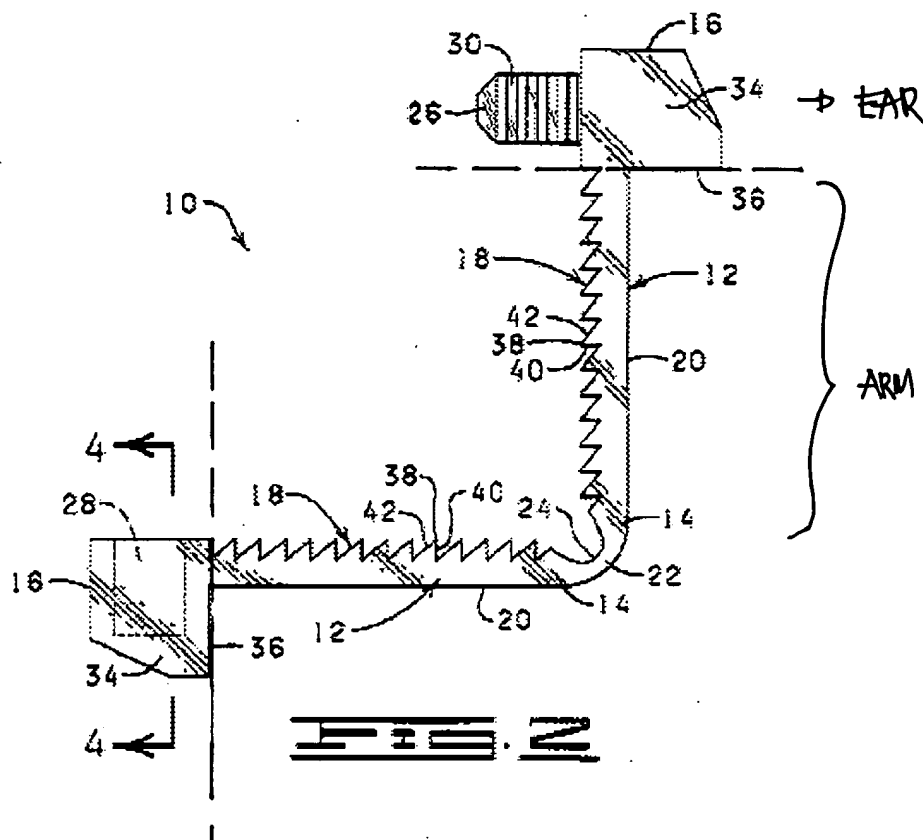
As to claim 120, 121, 124, 126, 127, 129, 131-135, 137, 138, 140, 142, 144-152, 154-157 and 165-167, Porter teaches a clip having a first arm and a second arm **12** disposed substantially opposite from each other; wherein the first and second arms define a gap capable of receiving a fold of tissue; wherein both the second and first arm includes integral anchoring portions **38** configured to maintaining a non-contacting relationship with each other of the first and second arms during a deployed state (see Figs. 6 and 7). The clip device of Porter is fully capable of being used as a clip for treating GERD or securing a fold of tissue. Porter also teaches the anchoring member **38** being fully capable of engaging a fold of tissue; wherein the anchoring member includes reverse angle barb (Fig. 5); wherein the anchoring portions includes two or more projections; wherein the projections are opposite of each other; wherein the distal end of the arms include a tapering portion; wherein the device further includes a gripping tab **36** at the distal end of the arms; wherein the device is bioabsorbable (col. 3, line 46); wherein the arms form a substantially U-shaped configuration (Fig. 6). It is noted that the device clip of Porter is fully capable of securing a flat piece of tissue (fundus) such that the lock tab penetrates said tissue. In this configuration, the tissue would be extending beyond a second end of the first and second arms.

More specifically for claims 129 and 142, Porter teaches an additional anchoring member **26** that is fully capable of piercing through tissue.

More specifically for claim 148, Porter teaches the projections **38** extending only partially into the gap (Fig. 7).

With regards to claims 168-171, Porter teaches the distal ends of the arms to be configured to maintain a non-contacting relationship with each other (as shown below).

For claims 168-171, ears **34** are not considered to be part of the arms. They merely extend from the distal end of the arms (col. 2, lines 64-65).



***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 130, 143 and 153 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porter in view of US 5,695,505 to Yoon.

Porter is silent with regard to the distal portion of the device having a tapered portion. However, Yoon teaches a similar clip, in which a distal end portion for both arms include a tapered portion (Fig. 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the clip of Porter to include the tapered portion taught by Yoon because it would help ease the desired/target tissue into the clip opening by providing a smooth surface for the tissue to glide on.

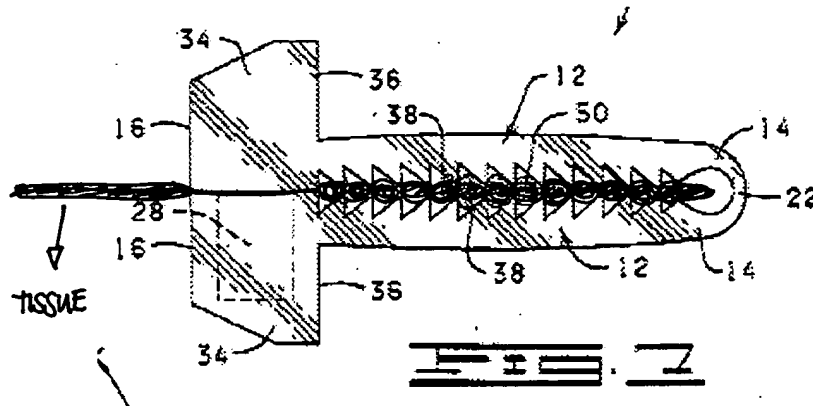
***Response to Arguments***

5. Applicant's arguments filed 1/31/06 have been fully considered but they are not persuasive.

6. The applicant's argument regarding the anticipation rejection is based on the argument that Porter allegedly fails to teach the arms defining a gap that allows tissue to extend from the connection beyond a second end of the arms when tissue is secured between the arms. However, this limitation is a mere functional limitation and that a recitation of the intended use of the claimed invention must result in a structural

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difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, Porter teaches a clip that is capable of piercing an elongated flat tissue, and that the lock tab is fully capable of penetrating tissue in a manner that tissue can extend beyond the second end of the claim. This is shown below.



### **Conclusion**

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any



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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darwin P. Erez who whose telephone number is (571) 272-4695. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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GLENN K. DAWSON  
PRIMARY EXAMINER